

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte COLIN A. WATERS and STEPHEN J. CHASKO

MAILED

AUG 14 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-2241
Application No. 09/827,291
Technology Center 3600

ON BRIEF

Before CRAWFORD, NAPPI and FETTNG Administrative Patent Judges.

NAPPI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 1 through 4, 6 through 11 and 13 through 17. Claims 5 and 12 have been canceled. For the reasons stated *infra* we affirm the examiner's rejection of these claims.

INVENTION

The invention relates to a system for implementing financial transactions using biometric data. See page 4 of appellants' specification. Claim 1 is representative of the invention and reproduced below:

1. A system for providing consumer access to a financial account to implement a transaction comprising:

a biometric data capture device for reading consumer biometric data; and

a database server for generating a data storage key from the consumer biometric data received from the biometric data capture device and for retrieving a financial account data record corresponding to the generated data storage key.

References

The references relied upon by the examiner are:

Pare et al. (Pare)	6,662,166	Dec. 9, 2003
		(effectively filed Aug. 29, 1996)
Musgrave	6,202,151	March 12, 2001
		(filed Dec 31, 1997)

Additional reference we discuss:

Pare et al. (Pare)	6,269,348	Jul. 31 2001
		(effectively filed August 29, 1996)

Rejection at Issue

Claims 1 through 4, 6 through 11 and 13 through 17 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Pare in view of Musgrave, the examiner's rejection is set forth on pages 2 through 4 of the answer. Throughout the opinion we make reference to the briefs, the answer and the final Office action for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, and for the reasons stated *infra* we will sustain the examiner's rejection of claims 1 through 4, 6 through 11, and 13 through 17 under 35 U.S.C. § 103.

Rejection of claims 1, 2, 6 through 11, and 13 through 15.

On pages 8 through 21 of the brief, appellants present arguments directed to claim 1 and the claims grouped with claim 1, claims 2, 6 through 11 and 13 through 15. Appellants argue, on pages 9 and 10 of the brief, that Pare is not proper prior art, as the filing date of Pare is June 11, 2001.

The examiner responds, on page 5 of the answer:

[T]he examiner has not relied on the earliest date of the parent application; as it appears to be the current application is a CIP of the original application filed [sic, filed] on November 28, 1994. However, the examiner relied on the earlier date of a direct continuation, which was parent application number 08/705,399 filed on August 29, 1996, now Patent No. 5,870,723, Examiner has reviewed both the immediate patents of Pare '166 and intervening patent Pare '348 as well as direct parent Pare '723 extensively and concluded that they are identical in content and all the portions of the Pare '166 that the examiner has relied on rejecting the current claims are included in the disclosures of the two immediate parent applications, which claim priority to August 29, 1996, the date the examiner has relied on for the rejections.

We concur with the examiner's determination that Pare is prior art. 35 U.S.C. § 120 states:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or..., which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings of the first application or on an application similarly entitled to the benefit of the filing date filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Initially we note that Pare '166 includes a reference to the prior applications as required under 35 U.S.C. § 120, and the prior applications contain the same inventors. While we note that we have reviewed patents 6,662,166; 5,870,723 and 6,269,348 (patent issued from application 09/239,570) and do not find that the disclosure of the three patents to be identical, we nonetheless find that the teachings of Pare 6,662,166 (hereinafter Pare '166) upon which the examiner relies upon are disclosed in Pare 6,269,348 (hereinafter Pare '348). Throughout our written opinion we will identify the teachings of Pare by referencing column and line number of both Pare '116 and Pare '348. The filing date of Pare '348 is January 29, 1999 which is prior to appellants' April 5, 2001 filing date. Thus, we concur with the examiner's finding that Pare' 166 is prior art as defined by 35 U.S.C. 102(e).

Appellants argue, on page 13 through 18 of the brief, that the examiner misconstrued the limitations of claim 1, specifically the term "key". On page 16 of the brief, appellants state:

[T]here is a distinction between values which form an index used to search for and retrieve records and values stored within the record that may be used after retrieval of the record for authentication. Accordingly, a "key" is a value that uniquely identifies a particular record so as to allow retrieval of the record. Thus, the generation of "a data storage key from the consumer biometric data" as recited in claim 1 means that the biometric data is used to generate a value that uniquely identifies a data storage record so that the data storage record may be retrieved. The claim further recites that the data storage record is "a financial account data record." Therefore, the plain meaning of the words in the claim is that the database server uses biometric data to generate a value which uniquely identifies a particular financial data record so that the financial data record may be retrieved.

Appellants argue that the examiner has read the term "key" out of the claim and as such has misinterpreted the claim language. Appellants further argue, on pages 18 and 19 of the brief, that Pare does not disclose a "database server for generating a data storage key from the customer biometric data received from the biometric capture device and for retrieving a financial record corresponding to the generated data storage key." Appellants argue, on page 19 of the brief, that the examiner's reliance upon Pare's teaching in columns 5 and 6 is erroneously equating verifying the identity of an individual with

identifying a financial account. Further, Appellants argue that Pare's Party Identifying Apparatus (PIA) is merely a sensor and does not generate a key used to obtain biometric data. On page 20 and 21 of the brief, appellants cite several sections of Pare to support the conclusion that "Pare clearly discloses the use of biometric data to identify an individual by comparing received biometric data with biometric data stored in a record. Pare fails, however, to disclose using a key generated from the biometric data to retrieve a financial account data record. Comparing data found in a file with received data is not the same as retrieving the file using the received data."

In response, on pages 6 and 7 of the answer, the examiner provides a brief discussion of the transmission of biometric data over a network, identifying the biometric data is transmitted as a code. Further, the examiner considers the code to be the key. Further, the examiner finds that Pare shows a database is used to store captured biometric data and financial account information.

We concur with the examiner's findings. Initially, we note that claim 1 recites: "A biometric data capture device for reading consumer biometric data; and a database server for generating a data storage key from the consumer biometric data received from the biometric data capture device and for retrieving a financial account data record corresponding to the generated data storage key." We accept the appellants' proffered definition of the term "key", thus the scope of claim 1 includes that a biometric data capture device, a database server, which receives this data and uses it to create a value that uniquely identifies a data storage record for a financial account and retrieves the financial account. Thus, the examiner's assertion that the transmitted code from the biometric sensor to the database meets the claimed "key" does not seem to meet our determination of the claim scope. Nonetheless, as discussed *infra* we do find that Pare teaches the claimed "key."

Pare teaches a system for token-less biometric electronic debit and credit transactions. (See title of Pare '348 or Pare '166). The system makes use of biometric sensors to obtain fingerprint data. (See Pare '348 column 8, lines 16 through 25 or Pare '116, column 8, lines 10 through 19). The data from these fingerprint sensors is

transmitted to a Data Processing Center (DPC) which use the data to identify the parties to a transaction. (See Pare '348 column 9, lines 38 through 43, 60 through 64 or Pare '166 column 9, lines 33 through 37 and 54 through 58). The DPC contains an ID module that can identify a person through several methods, biometric data and PIN, biometric data alone and digital certificates. (See Pare '348 column 11, lines 10 through 21 or Pare '166, column 11, lines 6 through 19). When using biometrics alone to identify a user the ID module makes use of a database of biometric samples to find a match. (See Pare '348, column 11, lines 50 through 67 or Pare '166 Column 11 lines 47 through 64). There is an Account Selector Subsystem, which selects accounts based upon the party being identified. Some parties have several accounts; in the case of the party having only one account, the account is automatically selected. (See Pare '348 column 12, lines 43 through 51 or Pare '166, column 11, lines 39 through 47). We find that, one skilled in the art would recognize that the determined identity of the party is the key used to determine the account. Thus, we find that Pare teaches the claim limitations of "A biometric data capture device for reading consumer biometric data; and a database server for generating a data storage key from the consumer biometric data received from the biometric data capture device and for retrieving a financial account data record corresponding to the generated data storage key."

Appellants argue, on pages 10 through 13 of the brief, that the examiner's rejection does not provide motivation to modify Pare with Musgrave as asserted by the examiner. Specifically, on page 11 of the brief and page 4 of the reply brief, appellants assert that the examiner's stated reasons are based upon conclusory rationale. Appellants assert that the examiner's cited reason for combining the references "enhancement of security as well as accuracy as well as computational resources" is not sufficient as Pare already purports to achieve these benefits.

The examiner, on page 3 of the answer, equates each of the limitations of claim 1 with Pare with the exception of stating:

What is not clear and explicit from the teachings of Pare [is] exactly how a digital signature (certificate) is generated from the biometric information (See Pare column 12, lines 5-23). However, Musgrave is specific and clear on application and use of specific biometric information and creating a hash value of the information and signing the biometric certificate and forwarding the data to the authenticating authority (See Musgrave column 6, line 15-column 6, line 24). Therefore, it would have been obvious to ... apply the Musgrave method and system with the system of Pare for the motivation of further enhancement of both security as well as reduction of computational resources (See Musgrave column 3, lines 8-22).

Initially, we note that independent claim 1 does not include a limitation directed to a “generating a digital signature from the biometric data,” however; claim 9 does contain such a limitation. Thus, it appears that Pare alone is relied upon to provide the disclosure that describes the limitations of claim 1, and as such it is immaterial to the rejection of claim 1 whether there is proper motivation to modify Pare to include generating a digital signature from the biometric data. Nonetheless, we are not persuaded by appellants’ argument. Pare teaches that communication between the PIA and the DPC can occur by many different communications methods and that the methods should be secure and that public/ private keys may be used (See Pare ‘348 Column 8, lines 29 through 39 or Pare ‘166, column 8, lines 23 through 33). Thus, Pare directly provides suggestion to use public or private keys to encrypt information. Musgrave teaches a system for increased security, by generating a digital certificate from biometric data and a public key. (See Column 3, lines 25 through 27 and lines 40 through 48). Thus, we find ample evidence of record to support the examiner’s finding of motivation to combine Pare and Musgrave.

For the forgoing reasons we sustain the examiner’s rejection of claim 1. On pages 21 and 22 of the brief, appellants argue that the rejection of claims 2, 8 through 11, and 13 through 15 is improper for the same reasons as discussed with respect to claim 1. Similarly, on pages 25 and 26 of the brief, appellants argue that the rejection of claims 6

and 7 is improper for the same reasons as discussed with respect to claim 1. Accordingly we also sustain the examiner's rejection of claims 2, 6 through 11 and 13 through 15.

Rejection of claims 3 and 4

On pages 22 through 24 of the brief, appellants argue that the examiner misconstrued the limitations of claim 3. Appellants assert, on page 24 of the brief, that the scope of claim 3 is such that "the identifier for the financial account includes nothing more than the obtained biometric data." Appellants argue that Pare does not teach direct retrieval of the financial information from the biometric data.

We are not persuaded by appellants' argument. Claim 3 recites "a system for supporting consumer access to a financial account by means of biometric data solely" including a "payment device for sending said captured biometric data to a merchant payment host as the identifier of the consumer's financial data." As discussed *supra* Pare teaches that a party can be identified in several manners including biometric data alone, and that when the party has registered only one account, the one account is automatically selected (as opposed to more than one account which requires additional user input to select the appropriate account). Thus, we find that Pare does teach accessing account information solely using biometric data.

On page 25 of the brief, appellants group claim 4 with claim 3. Accordingly, we also sustain the examiner's rejection of claim 4.

Rejection of claims 16 and 17.

Appellants argue, on page 27 of the brief:

[C]laim 16 recites that the data storage key is further based upon the name of the customer. The examiner alleges that this additional limitation is disclosed in Pare. (Office Action at page 6). The examiner has failed, however, to identify any portion of Pare which discusses the use of a consumer's name to generate a data storage key. Additionally, the Appellants have searched Pare and found no such teaching, disclosure or suggestion.

We disagree with appellants and find that Pare does teach using a personal identifier as a data key and as such provides suggestion to use name data to identify as a key. Claim 16 is dependent upon claim 15 and together they recite “capturing biometric data corresponding to a consumer … generating a key base upon the biometric data,” “obtaining name data corresponding to the consumer … identifying a plurality of data records based upon the name data” and “retrieving a previously stored data record from the identified plurality of data records based upon the data storage key.” The term “Name” is data that identifies a person. As discussed *supra* Pare teaches that a party can be identified by a combination of biometric data and PIN. In this embodiment the system searches the database for all matches to the PIN and then compares the biometric samples associated with the pin to the submitted biometric sample (Pares ‘348 column 11, lines 40 thorough 48 or Pare ‘166, column 11, lines 36 through 44). We note that while a PIN is not a name, they are both data identifiers of an individual, which amounts to printed matter. Our reviewing court has stated that “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” *In Re Ngai* 367 F.3d 1336, 1339, 70 USPQ2D 1862, 1864 (Fed. Cir. 2004, citing *In Re Gulack* 703 F. 2d 1381, 217 USPQ 401 (Fed. Cir. 1983)). Thus, we consider Pare’s step of using a PIN to retrieve a set of samples in a database to correspond to appellants’ claimed “identifying a plurality of records based on the name data.” Accordingly we find ample evidence to support the examiner rejection of claim 16.

On pages 28 and 29 of the brief, appellants argue that the rejection of claim 17 is improper for the reasons asserted with respect to claims 1 and 16. Accordingly, we sustain the examiner’s rejection of claim 17 for the reasons discussed with respect to claims 1 and 16.

Conclusion

In summary, we sustain the examiner's rejection of claims 1 through 4, 6 through 11, and 13 through 17 under 35 U.S.C. § 103. The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

MURRIEL E. CRAWFORD
Administrative Patent Judge

~~ROBERT E. NAPPI~~
Administrative Patent Judge

ANTON W. FETTING
Administrative Patent Judge

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